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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,990	08/06/2003	Dennis Wayne Rice	103864.134US1	7455
28089	7590	01/26/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			GRAY, LINDA LAMEY	
		ART UNIT		PAPER NUMBER
				1734
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Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/634,990	RICE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Linda L. Gray	1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 15 November 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 34-41,43-61,68 and 69 is/are pending in the application.
  - 4a) Of the above claim(s) 69 is/are withdrawn from consideration.
- 5) Claim(s) 37,41,43-45 and 49-52 is/are allowed.
- 6) Claim(s) 34-36,38-40,46-48,53-61, and 68 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**Detailed Action**

**Election/Restriction**

**1.** Newly submitted **claim 69** is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I.** **Claim 69**, drawn to a method, classified in class 156, subclass 227.
- II.** **Claims 34-41, 43-61, and 68**, drawn to an apparatus, classified in class 156, subclass 443.

The inventions are distinct, each from the other because of the following reasons: Inventions **I and II** are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as making a folded paper fan and bonding such to a flat elongated stick for making a paper fan.

**2.** Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 69 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP 821.03.

**Claim Rejections - 35 USC 103**

**3.** The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**4. Claims 34-36, 38-40, 46-48, 53-61, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vijuk (US 6,273,411 B1) in view of Fattal et al. (US 4,927,486).**

**Claims 34, 56, 59, and 68,** Vijuk teaches a system capable of labeling containers with an adhesive label including tool 153/155 capable of reducing a label,

device 152 capable of applying adhesive to the label and device 238 capable of conveying the label from the tool 153/155 to tool 156 which is capable of applying the label to the container (claim 35 too). Tool 153/155 folds the label by rolling it around and between a set of rollers. The system includes means 151 for providing the label to tool 153/155 (c 8-10).

***Claims 34, 56, 59, and 69, Vijuk does not teach (a) a barcode reader capable of scanning a barcode on the label (claims 34, 56, 59) or a label identifier (claim 68) and (b) that tool 156 includes a device capable of applying adhesive to the label.***

For (a) above, Fattal et al. teach a system capable of labeling containers 1 with an adhesive label including tool 11 capable of applying the finished label to container 1. Fattal et al. teach that the system includes barcode reader 12 (a label identifier) capable of scanning a barcode on the label. Reader 12 is provided to scan the barcode after labeling to determine if the correct label has been applied and if the label is in the correct location (c 2-3).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Vijuk a barcode on the labels (although it is considered that the labels of Vijuk include a barcode in that labels of medication bottles include barcodes) and to have provided the system with a barcode reader (a label identifier) capable of scanning the barcode because Fattal et al. teach that such allows one to determine if the correct label has been applied and if the label is in the correct location.

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For (b) above, it is conventional in the art to provide labeling systems with devices capable of applying the labeling adhesive, and it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Vijuk that tool 156 includes a device capable of applying the labeling adhesive to the label such that the labels in tool 156 are ready for application as required by the reference and as is conventional in the art.

**Claims 34, 56, 59, and 68,** The limitations that the container includes a medication and that the container is a bottle or a package are not positive limitations for the claimed system and refers to an item worked upon by the system. In any event, Vijuk teaches the containers to include medication. The system of Vijuk is also capable of labeling bottles and packages. The limitation that the label includes information regarding the medication to a consumer or patient information refers to specifics about the label operated upon by the claimed system and is not a positive limitation for the claimed system. In any event, the label of Vijuk includes medicinal information to a consumer. The limitation that the adhesive is provided such that the label is capable of being maintained in a reduced orientation refers to the use of the adhesive applied to by claimed system and does is not a positive limitation for the claimed system. In any event, the adhesive from tool 152 in Vijuk is provided such that the label is capable of being maintained in its reduced orientation when folded by tool 153/155. The limitation that the barcode reader facilitates correct matching of the label to the container refers to the use of the information scanned by the reader and is not written as a positive limitation to the claimed system. In any event, Fattal et al. teach this limitation such that it is present in the combination of Vijuk in view of Fattal et al. The same reasoning applies to the label limitations **claims 46-48 and 55**. Specifically, for **claim 55** the adhesive applied by device 152 enables the label to be unrolled and resecured in the rolled shape by a user without damage is not positive limitation for the claimed system itself but refers to how the label functions after application. In any event, Vijuk's label is capable of this function.

**Claims 36, 53, 57, and 60,** the system of Vijuk is automatic and thus suggests a controller for operation. **Claim 38**, Vijuk teaches at least one creasing wheel which creases the label as the label is folded by tool 153/155. **Claim 39**, Vijuk teaches a second creasing wheel which also creases after the first wheel. **Claims 58 and 61**, the system includes means for removing the label from tool 153/155 and includes the nip rollers at the exit of tool 153/155.

**Claim 40**, *Vijuk does not teach device 238, a conveyor, to include a vacuum pad.*

However, vacuum pads under conveyor belts are conventional in the label transport art to keep the labels in position before being picked up for application to

ensure the labels are not skewed, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Vijuk that conveyor device 238 includes a vacuum pad thereunder.

***Claim 54, Vijuk is silent as to specifics of device 156, i.e., that device 156 includes a robotic arm and a controller for the arm.***

However, robotic arms with controllers are conventional in the labeling art to ensure a more accurate label placement, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Vijuk a robotic arm with a controller for label application.

**5. Claims 59-61 are ejected under 35 U.S.C. 103(a) as being unpatentable over Hoffmann (US 4,181,555) in view of Fattal et al.**

***Claim 59,*** Hoffmann teaches a system (Fig 1) capable of labeling container 17 (c 1, L 1-13) including the following:

- (a)** means 40/41 for preparing label 13 for attachment where means 40/41 reduces a label size via cutting label 13 from a web (c 3, L 25, to c 5, L 27),
- (b)** means 37/38 for providing the web of intended labels 13 to means 40/41,
- (c)** means 28 for applying an adhesive to label 13 (c 2, L 52, to c 3, L 10),
- (d)** means 25 for transporting label 13 to means 28 (c 3, L 1-10), and
- (e)** means 20/20 for using the adhesive to attach label 13 to container 17 (c 2, L 52-66).

***Claim 59, Hoffmann does not teach a barcode reader capable of scanning a barcode on the label.***

In view of Fattal et al. it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Hoffmann a barcode on labels 13 (although it is considered that labels 13 of Hoffmann include a barcode in that labels of Hoffmann include barcodes) and to have provided the system with a barcode

reader capable of scanning the barcode because Fattal et al. teach that such allows one to determine if the correct label has been applied and if the label is in the correct location.

**Claim 59**, the limitations that the container includes a medication and that the container is a bottle or a package are not positive limitations for the claimed system and refers to an item worked upon by the system. The system of Hoffman is capable of labeling containers having medication therein. The system also labels bottles and packages are capable of being labeled. The limitation that the label includes information regarding the medication to a consumer refers to specifics about the label operated upon by the claimed system and is not a positive limitation for the claimed system. In any event, the system of Hoffman is capable of labeling with such labels. The limitation that the barcode reader facilitates correct matching of the label to the container refers to the use of the information scanned by the reader and is not written as a positive limitation to the claimed system. In any event, Fattal et al. teach this limitation such that it is present in the combination of Hoffmann in view of Fattal et al.

**Claim 60**, Hoffmann teaches the apparatus to be automatic thus teaching means for controlling an operation of the system. Claim 61, Hoffmann teaches means 42 (Fig 1) for removing label 13 from means 40/41 which are rollers.

**6. Claims 34-36, 38-40, 46-48, 53-61, and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Voltmer et al. (US 4,502,910) in view of Vijuk and Fattal et al.**

**Claim 59**, Voltmer et al. teach system 20 for labeling container 24 (c 2, L 1-7) including the following:

(a) means 101 for applying an adhesive to folded label 28 (c 1, L 19-37; c 3, L 47-51),

(b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26), and

(c) means 108 for using the adhesive to attach label 28 to container 24 (c 4, L 19-29).

**Claim 59**, although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al.

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*do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) where Voltmer et al. also do not teach a feeder for the reducing means.*

In view of Vijuk it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) and a feeder for the reducing means; because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

*Also, for claim 59, Voltmer et al. do not teach a barcode reader capable of scanning a barcode on the label.*

In view of Fattal et al. it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a barcode on labels 28 (although it is considered that labels 28 of Voltmer et al. include a barcode in that labels of Voltmer include barcodes) and to have provided the system with a barcode reader capable of scanning the barcode because Fattal et al. teach that such allows one to determine if the correct label has been applied and if the label is in the correct location.

**Claim 59**, the limitations that the container includes a medication and that the container is a bottle or a package are not positive limitations for the claimed system and refers to an item worked upon by the system. In any event, Voltmer et al. teach the containers to include medication and the system labels bottles and packages. The limitation that the label includes information regarding the medication to a consumer refers to specifics about the label operated upon by the claimed system and is not a positive limitation for the claimed system. In any event, the label of Voltmer et al.

includes medicinal information to a consumer. The limitation that the barcode reader facilitates correct matching of the label to the container refers to the use of the information scanned by the reader and is not written as a positive limitation to the claimed system. In any event, Fattal et al. teach this limitation such that it is present in the combination of Voltmer et al. modified in view of Fattal et al.

**Claim 60**, Voltmer et al. teach means 132 for controlling system 20 (c 4, L 19-53). **Claim 61**, Voltmer et al. teach means 111 for removing labels 28 from means 101 which is in roll form on item 116.

**Claims 34-35 and 68**, Voltmer et al. teach system 20 for labeling medicinal container 24 (c 2, L 1-7) including the following:

(a) means 101 for applying an adhesive to folded label 28 (c 1, L 19-37; c 3, L 47-51), and

(b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26).

*Claims 34 and 68, although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al. do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) where Voltmer et al. also do not teach means for applying adhesive to keep label 28 reduced.*

In view of Vijuk it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28) and a means for applying adhesive to keep label 28 folded because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

*Also, for claims 34 and 68, Voltmer et al. do not teach a barcode reader capable of scanning a barcode on the label (a label identifier, claim 68).*

In view of Fattal et al. it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a barcode on labels 28 (although it is considered that labels 28 of Voltmer et al. include a barcode in that labels of Voltmer et al. include barcodes) and to have provided the system with a barcode reader (a label identifier) capable of scanning the barcode because Fattal et al. teach that such allows one to determine if the correct label has been applied and if the label is in the correct location.

**Claims 34 and 68**, the limitations that the container includes a medication and that the container is a bottle or a package are not positive limitations for the claimed system and refers to an item worked upon by the system. In any event, Voltmer et al. teach the containers to include medication and the system labels bottles and packages. The limitation that the label includes information regarding the medication to a consumer refers to specifics about the label operated upon by the claimed system and is not a positive limitation for the claimed system. In any event, the label of Voltmer et al. includes medicinal information to a consumer or patient information. The limitation that the adhesive is provided such that the label is capable of being maintained in a reduced orientation refers to the use of the adhesive applied to by claimed system and does is not a positive limitation for the claimed system. In any event, the adhesive in Voltmer et al. modified is provided such that the label is capable of being maintained in its reduced orientation when folded. The limitation that the barcode reader facilitates correct matching of the label to the container refers to the use of the information scanned by the reader and is not written as a positive limitation to the claimed system. In any event, Fattal et al. teach this limitation such that it is present in the combination of Voltmer et al. in view of Fattal et al. The same reasoning applies to the label limitations **claims 46-48 and 55**. Specifically, for claim 55 that the adhesive applied by Voltmer et al. in view of Vijuk enables the label to be unrolled and resecured in the rolled shape by a user without damage is not positive limitation for the claimed system itself but refers to how the label functions after application. In any event, Voltmer et al. in view of Vijuk's label is capable of this function.

**Claim 36**, Voltmer et al. teach means 132 for controlling system 20 (c L 19-53). **Claims 38-39**, Voltmer et al. modified teach at least two creasing wheel which crease label 28 as label 28 is being folded by the reducing means (Fig 12 of Vijuk, and related

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discussion). **Claim 40**, in Voltmer et al. pick-up bar 103 is a vacuum pad that enables label 28 to be kept in a secure position during transport (c 3, L 16-28).

**Claims 56 and 58**, Voltmer et al. teach system 20 for labeling medicinal container 24 (c 2, L 1-7) including the following:

(a) means 101 for applying an adhesive to folded label 28 (c 1, L 19-37; c 3, L 47-51),

(b) a means for transporting label 28 to means 101 where this means includes hopper 102, plunger 124, and pick-up bar 103 (c 3, L 16-26), and

(c) means 108 for using the adhesive to attach label 28 to container 24 (c 4, L 19-29).

*Claim 56, although labels 28 of Voltmer et al. are provided for in some manner, Voltmer et al. do not elaborate on how labels 28 are provided. Specifically, Voltmer et al. do not teach that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28 by rolling and creasers).*

In view of Vijuk it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a means for forming labels 28 using the means taught by Vijuk, i.e., that the means for transporting gets labels 28 from a means for reducing labels 28 which prepares labels 28 (in this case, folds into folded labels 28 by rolling and creasers) because it is obvious to replace one means for providing and forming labels 28 (that of Voltmer et al. not specifically disclosed) with an art recognized means (that of Vijuk).

*Also, for claim 56, Voltmer et al. do not teach a barcode reader capable of scanning a barcode on the label.*

In view of Fattal et al. it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a barcode

on labels 28 (although it is considered that labels 28 of Voltmer et al. include a barcode in that labels of Voltmer et al. include barcodes) and to have provided the system with a barcode reader capable of scanning the barcode because Fattal et al. teach that such allows one to determine if the correct label has been applied and if the label is in the correct location.

**Claim 56,** The limitations that the container includes a medication and that the container is a bottle or a package are not positive limitations for the claimed system and refers to an item worked upon by the system. In any event, Voltmer et al. teach the containers to include medication and the system labels bottles and packages. The limitation that the label includes information regarding the medication to a consumer refers to specifics about the label operated upon by the claimed system and is not a positive limitation for the claimed system. In any event, the label of Voltmer et al. includes medicinal information to a consumer. The limitation that the barcode reader facilitates correct matching of the label to the container refers to the use of the information scanned by the reader and is not written as a positive limitation to the claimed system. In any event, Fattal et al. teach this limitation such that it is present in the combination of Voltmer et al. in view of Fattal et al.

**Claim 57,** Voltmer et al. teach means 132 for controlling system 20 (c 4, L 19-53).

**Claims 53-54,** Voltmer et al. teach automated device 108 for affixing label 28 to container 24 but does not teach, instead, a robotic arm with a controller.

However, robotic arms with controllers are conventional in the labeling art to ensure a more accurate label placement, and for this reason it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have provided in Voltmer et al. a robotic arm with a controller instead of roller 108.

**Allowable Subject Matter**

**7. Claims 37, 41, 43-45, and 49-52 are allowed.**

**8. The following is an examiner's statement of reasons for allowance:**

**claim 37:** the closest prior arts of record to Vijuk and Voltmer et al. do not teach that the label reducing tool includes a flat, rectilinear device with first and second ends with at least one of the ends being attached to a rotation device wherein the rotation device enables the label reducing tool to be rotated along an axis of rotation in that Vijuk and Voltmer et al. in view of Vijuk teach a different reducer;

**claim 41:** the closest prior arts of record to Vijuk and Voltmer et al. do not teach that the system includes a spring loaded ridge which enables the label to be removed from the label reducer without causing damage to the label in that Vijuk and Voltmer et al. in view of Vijuk teach a different device for removal which is the set of nip rollers at the exit of the reducer tool;

**claim 43:** the closest prior arts of record to Vijuk and Voltmer et al., both in view of Fattal et al., do not teach that the system includes another barcode reader capable of scanning the barcode before the label is folded by the reducer tool in that Fattal et al., the secondary reference, teach just one barcode scanner; and

**claim 50:** although label rejection mechanisms, including a disposal assembly (see JP 5-147636), are convectional in the labeling art to rid a process of defective labels, the closest prior arts of record do not teach a mechanism including a pair of needles capable of being advanced through the label as the label lies on device 238, a stripper plate capable of holding the label in place on device 238 as the needles are applied to the label.

**9.** As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP 707.07(a).

**Response**

**10.** Applicant's response filed 11-15-05 is noted. The allowability of the subject matter of previous claim 42, as indicated in the prior Office action is withdrawn in view of the newly discovered reference to Fattal et al. The comments are moot in view of the new grounds of rejections stated above.

**Conclusion**

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**11.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linda Gray whose telephone number is (571) 272-1228. The examiner can normally be reached Monday-Friday from 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-1997 (toll-free).

llg *llg*  
January 23, 2006

*Linda Gray*  
LINDA GRAY  
PRIMARY EXAMINER